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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,821	03/26/2001	Keith Hall	SMX 3071.1 (99-22R1)	7846

321 7590 12/02/2002

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EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,821

Applicant(s)

HALL ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-89 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-72, drawn to a process for preparing and screening an array of metal-ligand compositions with polymerization mixture of the array, classified in class 436, subclass 73.
 - II. Claims 73-89, drawn to a process for preparing and screening an array of metal-ligand compositions with reaction mixture of the array, classified in class 436, subclass 139.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different method steps that have different functions and modes of operation. The method step of preparing an array of polymerization mixtures in which each polymerization mixture of the array comprise of a polymerization monomer and a metal-ligand composition of Group I is not required by the claims of Group II. The method step of preparing an array of reaction mixtures in which each reaction mixture of the array comprise of a non-protic medium, a reactant for a chemical reaction of interest and a metal-ligand composition of Group II is not required by the claims of Group I.

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3. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group II would involve a determination of the patentability of a method comprise of the combination of a composition comprising a non-protic medium, a reactant for a chemical reaction of interest and a metal-ligand composition (independent of its use) while a patentability determination for Group I would involve a consideration of the patentability of a method comprise of the combination of a composition comprising a polymerization monomer and a metal-ligand composition (independent of its use). These considerations (combination of a composition) are very different in nature.

4. This application contains claims directed to the following patentably distinct species of the claimed invention.

5. If applicants elect the invention of **Group I (Claims 1-72)**, applicants are required to further elect *one* species from *each* group below.

Species 1: Type of soluble metal precursor

- | | |
|---------------------------|----------|
| A. Formula MR_n ** | Claim 6 |
| B. Formula MR_nL_m ** | Claim 7 |
| C. Formula $M_pR_nL_m$ ** | Claim 8 |
| D. Formula LnR_3 ** | Claim 39 |
| E. No Formula | Claim 69 |

****Note:** within each of these species with respect to the moieties denoted as M (metal), R (solublizing ligand), L (neutral solublizing ligand), Ln, R₃, p, n, or m *a single selection of each of these entities should be made.*

Species 2: Type of coordination number of Claims 16, 18, and 19-20

Species 3: Type of Charge of Claims 17 and 19

Species 4: Type of metal-binding ligand of Claim 21

Species 5: Type of activators of Claims 48-52

Species 6: Type of property of Claim 56

Species 7: Type of method of Claim 57

Species 8: Number of Ligands of Claims 58-64

Species 9: Type of deprotonating agent of Claim 71

6. If applicants elect the invention of **Group II (Claims 73-89)**, applicants are required to further elect *one* species from *each* group below.

Species 10: Type of reaction product of Claim 75

Species 11: Type of soluble metal precursor

- | | |
|---------------------------|----------|
| A. Formula MR_n ** | Claim 78 |
| B. Formula $M_pR_nL_m$ ** | Claim 79 |
| C. No Formula | Claim 80 |

****Note:** within each of these species with respect to the moieties denoted as M (metal), R (solublizing ligand), L (neutral solublizing ligand), L_n , R_3 , p, n, or m *a single selection of each of these entities should be made.*

Species 2: Type of coordination number of Claim 85

Species 3: Type of Charge of Claim 86

Species 4: Type of metal-binding ligand of Claim 87

7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally

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held to be allowable. *Currently, claims 1-5, 11-15, 47, 54-55, 65, 68, 70, 72-74, 76-77, 84 are generic.*

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on **Increased Flex Schedule** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
November 30, 2002


PADMASHRI PONNALURI
PRIMARY EXAMINER